

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

IN RE APPLICATION
OF: GEWEHR ET AL.
SERIAL NO. 10/616,950
FILED: JULY 11, 2003
FOR: FUNGICIDAL USE

DOCKET NO.: AM200040
CONFIRMATION NO.: 2161
GROUP ART UNIT: 1616
EXAMINER: SABIHA N. QAZI

Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF UNDER 37 C.F.R. §41.41

Sir:

Appellants stand by the position taken in their main Brief on Appeal dated August 28, 2006. Additionally, appellants respectfully submit the following Supplemental Remarks in reply to the Examiner's Answer dated July 31, 2007.

Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees, to Deposit Account No. 14.1437. Please credit any excess fees to such deposit account.

Respectfully submitted,
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SUPPLEMENTAL REMARKSREGARDING NO. (3) OF THE EXAMINER'S ANSWER:¹⁾

The Examiner criticized appellants' statement of the Status of the Claims for failing to set forth which claim is canceled, original, or amended.

It is respectfully noted that 37 C.F.R. §41.37(c)(1)(iii) requires that the claim status such as "*rejected, allowed or confirmed, withdrawn, objected to, canceled*" be identified in the subsection "*Status of Claims*." Accordingly, appellants' Brief on Appeal sets forth on page 2/14 that

- Claims 1, 2, 4 and 5 stand rejected;
- Claim 3 was canceled in a preliminary amendment submitted upon filing of the application;
- No Claim(s) stand(s) allowed;
- No Claim(s) stand(s) objected to; and
- No Claim(s) stand(s) withdrawn from consideration.

On the one hand, appellants clearly identified the canceled claim(s) in the requisite section of the Brief. On the other hand, appellants respectfully urge that the claim status which is to be identified in accordance with 37 C.F.R. §41.37(c)(1)(iii), "e.g., *rejected, allowed or confirmed, withdrawn, objected to, canceled*," is deemed to differ from the status identifiers which are required in accordance with 37 C.F.R. §1.121(c), namely "*(Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered)*." In spite of the overlap with regard to a claim which stands "*withdrawn*" or which was "*canceled*", the identification of a claim status as "*original*" or "*amended*" is not deemed to fall within the pertinent information about the Status of the Claims which is required under 37 C.F.R. §41.37(c)(1)(iii).

The Examiner's position that appellants' statement of the Status of the Claims was incorrect is therefore deemed to be in error.

REGARDING NO. (7) OF THE EXAMINER'S ANSWER:²⁾

The Examiner criticized appellants' Claims Appendix as containing "*substantial errors*" for not showing the status of each claim.

It is again respectfully noted that the status of each claim, e.g., rejected, allowed or confirmed, withdrawn, objected to, canceled, is found in the subsection "*Status of Claims*" on page 2/14 of the main Brief on Appeal. 37 C.F.R. §41.37(c)(1)(viii) provides that the Claims Appendix

1) Cf. Examiner's Answer page 2, lines 7 to 9.

2) Cf. Examiner's Answer page 3, lines 1 to 4.

contain “*a copy of the claims involved in the appeal.*” The inclusion of status identifiers in the Claims Appendix is therefore not deemed to be necessary.

The Examiner’s position that appellants’ Claims Appendix contained “*substantial errors*” for not showing the status of each claim is therefore deemed to be in error.

REGARDING NOS. (9) AND (10) OF THE EXAMINER’S ANSWER:³⁾

The Examiner maintained that the subject matter of appellants’ Claims 1, 2, 4 and 5 was unpatentable under the judicially created doctrine of obviousness-type double patenting in light of Claims 1 to 5 of *Sieverding et al.* (US-A 6,696,497).

As submitted by appellants in their Brief on Appeal, it is well settled that a double patenting rejection of the obviousness type is analogous to a failure to meet the non-obviousness requirement of 35 U.S.C. §103 except that the reference underlying the double patenting rejection is not considered prior art. Therefore, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. §103 obviousness determination,⁴⁾ and corresponding to a determination of obviousness under Section 103(a), it is the *invention as a whole* which must be considered when an analysis of obviousness-type double patenting is made.⁵⁾

A determination of patentability under 35 U.S.C. §103 should be made upon the facts of the particular case in view of the totality of the circumstances,⁶⁾ and the use of *per se* rules is improper for determining whether claimed subject matter would have been obvious under 35 U.S.C. §103.⁷⁾ More specifically, the Courts have held that the fact that a claimed subgenus is encompassed by a prior art genus is not sufficient by itself to establish a *prima facie* case of obviousness.⁸⁾ In fact, the Federal Circuit has “[d]ecline[d] to extract from *Merck & Co. v. Biocraft Laboratories Inc.*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir. 1989)] the rule that ... regardless of how broad, a disclosure of a chemical genus renders obvious any species that happens to fall within it.”⁹⁾

3) Cf. Examiner’s Answer page 3, line 10, to page 6, line 14.

4) Cf. *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Braat*, 837 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991).

5) Cf. *In re Antonie*, 559 F.2d 618, 620, 195 USPQ 6, 8 (CCPA 1977).

6) See, e.g., *In re Dillon*, 919 F.2d 688, 692–93, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990) (in banc).

7) See, e.g., *In re Brouwer*, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1996); *In re Ochiai*, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995); *In re Baird*, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994).

8) *In re Baird*, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994) (“The fact that a claimed compound may be encompassed by a disclosed generic formula does not by itself render that compound obvious.”).

9) *In re Jones*, 958 F.2d 347, 350, 21 USPQ2d 1941, 1943 (Fed. Cir. 1992). See also *In re Deuel*, 51 F.3d 1552, 1559, 34 USPQ2d 1210, 1215 (Fed. Cir. 1995).

As noted by appellants in their Brief on Appeal, the claims of *Sieverding et al.* relate to a fungicidal composition¹⁰⁾ which comprises synergistically effective amounts of

- (a) a benzophenone which generically encompasses appellants' compounds (I) and the compound 5-bromo-2',6-dimethyl-2,4',5',6'-tetramethoxybenzophenone, and
- (b) a valinamide compound represented by a formula (II),

and which is effective against a broad variety of phytopathogenic fungi.¹¹⁾ According to the reference, the synergistic mixture of (a) and (b) may be applied in particular for controlling phytopathogenic fungi of 29 different genera with an emphasis on the species *Plasmopara viticola*, *Phytophthora sp.*, *Pseudoperonospora sp.*, and *Bremia sp.*¹²⁾ The reference to the genus "*Pseudocercospora*" among the 29 different genera is deemed to be by far too general to direct the attention of a person of ordinary skill in the pertinent art to the species *Pseudocercospora herpotrichoides*.

It is appellants' position that the claimed methods differ from the claims of *Sieverding et al.* at least in that *Sieverding et al.*'s claims refer to synergistically effective amounts of the components (a) and (b) whereas appellants' method requires that the compound (I) be applied in amounts which are effective for controlling a certain fungus. *Sieverding et al.*'s examples corroborate that synergistically effective amounts of a combination of the ingredients (a) and (b) does not require that the ingredient (a), when applied alone, be present in amounts which are effective for controlling the respective fungus.¹³⁾

Moreover, appellants' method differs from the claims of *Sieverding et al.* because *Sieverding et al.*'s claims require that a combination of the ingredients (a) and (b) be employed for controlling the growth of fungi in general whereas appellants' method requires that the compound (I) be employed in amounts which control the particular species *Pseudocercospora herpotrichoides*. Appellants have presented data regarding the effectivity of the compound (I.1)¹⁴⁾ in the control of various species from 9 of the 29 genera which are mentioned by *Sieverding et al.*, namely the species:¹⁵⁾

Alternaria solani	Early blight	ALTESO P1
Botrytis cinera	Grey mold	BOTRCI P1
Fusarium culmorum	Culm rot	FUSACU P1
Phytophthora infestans	Late blight	PHYTIN P1

10) Cf. col. 1, indicated lines 7 to 65, of US 6,696,497.

11) Cf. col. 6, indicated lines 10 to 24, of US 6,696,497.

12) Cf. col. 6, indicated lines 10 to 24, of US 6,696,497.

13) Cf. Tables I and II in cols. 11 and 12 of US 6,696,497.

14) Compound (I.1) according to appellants' invention corresponds to the compound designated as "BP-4" by *Sieverding et al.*; cf. col. 4, indicated lines 59 and 60, of US 6,696,497.

15) Cf. Brief pages 4/14 and 9/14.

Plasmopara viticola	Grape downy mildew	PLASVI P1
Pseudocercospora herpotrichoides	Eyespot / Stem break	PSDCHE P1
Puccinia recondite	Brown rust	PUCCRT K1
Pyricularia oryzae	Rice blast	PYRIOR P1
Pyrenophora teres	Net blotch	PYRNTE P1

When the compound (I.1) was applied in an amount of 250 ppm to control of the fungus *Pseudocercospora herpotrichoides* in accordance with appellants' method, the fungal attack was reduced from 90% of a control experiment to 0%. However, in the comparative methods in which the compound (I.1) was applied in the same amounts to control one of the other species, no control of the fungi was achieved.¹⁶⁾

Appellants' investigations clearly corroborate that the claimed method achieves advantages which could not have been expected on the basis of the subject matter defined by Claims 1 to 5 of *Sieverding et al.*

CONCLUSION

In light of the foregoing reasons and explanations as well as the explanations already presented by appellants in their main Brief on Appeal, appellants stand by the position that the Examiner's final rejection of Claims 1, 2, 4 and 5 under the judicially created doctrine of obviousness-type double patenting on the basis of Claims 1 to 5 of *Sieverding et al.* was in error. The request that the Examiner's respective rejection be reversed is therefore maintained. Favorable action is respectfully solicited.

16) Cf. Dr. Stierl's Declaration dated January 16, 2006, in particular page 7/8.